

United States
Court of Appeals
For the Ninth Circuit

HARRY X. BERGMAN, PERMA-LOX ALUMINUM SHINGLE CORPORATION and VICTOR H. LANGVILLE, doing business under the assumed name of LANGVILLE MANUFACTURING COMPANY,

Appellants,

vs.

ALUMINUM LOCK SHINGLE CORPORATION OF AMERICA,

Appellee.

Appellants' Brief

On Appeal from the United States District Court for the District of Oregon

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Appellants' Brief

On Appeal from the United States District Court for the District of Oregon

STATEMENT OF JURISDICTION

Jurisdiction of District Court

This is a suit for infringement of Korter patent No. 2,631,552 (Tr. 309, PX 1)¹ brought by plaintiff, Aluminum Lock Shingle Corporation of America, as the assignee of the entire right, title and interest in and to said patent, and jurisdiction is based upon the patent laws of the United States and particularly 35 U.S.C.A. Sec. 281:

“A patentee shall have remedy by civil action for infringement of his patent.”

¹“Tr.” denotes the page of the printed record of the transcript of the trial; “PX” plaintiff’s exhibits; “DX” defendants’ exhibits.

Jurisdiction of Court of Appeals

This is an appeal from a decree (Tr. 54) finally adjudicating Korter patent No. 2,631,552 to be valid and infringed by defendants and granting an injunction permanently enjoining defendants from making, using or selling aluminum shingles which infringe said patent. Such a decree is appealable under 28 U.S.C.A. Sec. 1292 (1), (4):

“The courts of appeals shall have jurisdiction of appeals from:

“(1) Interlocutory orders of the district courts of the United States, the District Court for the Territory of Alaska, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court;

* * *

“(4) Judgments in civil actions for patent infringement which are final except for accounting.”

STATEMENT OF THE CASE

This is an appeal from a decree (Tr. 54) holding valid and infringed the single claim of Korter patent No. 2,631,552 (PX 1, Tr. 309) on which plaintiff, assignee of the patent, sued defendants.

Defendant Harry X. Bergman is president of defendant Perma-Lox Aluminum Shingle Corpora-

tion which sold the aluminum shingle (PX 3) charged to be an infringement of the Korter patent which were manufactured by defendant, Langville Manufacturing Company.

The Korter patent is for an alleged improvement in metal roofing shingles. The Korter patent issued on March 17, 1953, on application Serial No. 137,566, filed on January 9, 1950. The bill of complaint (Tr. 3) charges defendants with infringement of the Korter patent and defendant Harry Bergman with unfair competition in the sale of the accused aluminum shingles. Defendants Bergman and Perma-Lox answered (Tr. 10), denying infringement and validity of the Korter patent and counterclaimed for a judgment of invalidity and noninfringement and also counterclaimed for unfair competition and anti-trust law violation. Defendant, Victor H. Langville, separately answered the complaint denying validity of the Korter patent and for an adjudication that defendant did not infringe the claim of the patent (Tr. 24).

At the pretrial conference, the District Judge directed that the issues of validity and infringement of the Korter patent be segregated from the other issues in the case and be tried first (Tr. 35). The ensuing trial was limited to the issues of validity and infringement which were finally disposed of favorably to plaintiff as per the Decree and Findings of Fact and Conclusions of Law (Tr. 46).

Subject Matter Involved

The Korter patent is for an aluminum shingle of the interlocking type. Plaintiff's physical Exhibit 2 is a shingle made in accordance with the patent. The object of the invention is stated in the patent (Tr. 311) as follows (column 1, lines 6 to 9):

“The main object of this invention is to devise a metal shingle of the interlocking type in which provision is made to prevent leakage from heavy runoff, on condensation, or both.”

and the invention is clearly stated to be (column 1, lines 17-19):

“Fig. 3 is a fragmentary perspective view of one corner of the shingle showing *the drain slot which forms the basis of this invention.*” (Emphasis added).

Referring to the drawings of the patent (Tr. 310), the shingle comprises a flat, rectangularly shaped piece of metal longitudinally divided into panels 10 by grooves 12. The edges of the shingle (13, 14, 16 and 17) are reversely turned. A nailing tab 15 is provided in the upper right-hand corner, and a drain slot 21 is located near corner 22 of the bottom reversely turned edge or gutter 16. When the shingles are assembled on a roof, the reversely curved edge portions interlock with similar portions on adjacent shingles. As shown in Fig. 4, any water which may get under a shingle will be accumulated in gutter 16 and run out through drain slot 21 onto the outside surface of the next lower adjacent shingle.

Broadly speaking, the accused shingles (PX 3) are similar to the patented ones with the important exception that the accused do not have a drain slot in the bottom reversely turned edge of the shingle. The accused shingles have an open corner corresponding to corner 22 in the Korter patent.

History of the Korter Patent

Korter filed two patent applications (DXs 28 & 29) in the Patent Office and while the patent in suit actually issued upon the later filed application (DX 29), plaintiff maintained, and the District Court found, Conclusion 6 (Tr. 53), that the later filed application was entitled to the filing date of the earlier application for all subject matter common to the two applications. In order to decide the questions of validity and infringement both file wrappers must be examined.

A. The Earlier Filed and Abandoned Application

Korter filed his first patent application Serial No. 776,332 (DX 28) in the United States Patent Office on September 26, 1947. The shingle disclosed in this original patent application was the same as the shingle disclosed in the patent in suit except that the first shingle did not have a drain slot as shown in the patent. All of the claims of the first patent application were finally rejected by the Patent Office as being fully met by the prior art. An appeal was taken to the Board of Appeals of the Patent Office which decided the appeal adversely to Korter on July 24, 1952 (DX 28, paper #15).

A civil action under R. S. 4915 was then filed in the United States District Court for the District of Columbia entitled "Louis J. Korter v. John A. Marshall, Commissioner of Patents, Civil Action No. 549-52," in an effort to compel the Commissioner of Patents to issue a patent upon the rejected application (DX 28, paper #17). That action, however, never went to trial and the patent application was abandoned on March 13, 1953, by a stipulation dismissing the case with prejudice as to all claims in the application.

B. The Later Filed Application of the Patent in Suit

The second application (DX 29) was filed in the United States Patent Office on January 9, 1950, and it was upon this application that the patent in suit ultimately issued. This application refers to the prior application and shows, describes, and claims drain slot 21 which is the only material difference between the two applications. Throughout the entire prosecution of the second application, the importance of the drain slot was stressed before the Examiner, and was the reason for allowance of the only claim in the patent. It was the sole detail not shown in any of the prior art patents cited by the Examiner.

The Korter Patent is Limited to a Shingle with a Drain Slot

The claim of the Korter patent in suit is of the combination type and calls for the following elements:

- (1) a flat, rectangularly shaped metal shingle;

- (2) corrugations forming ridges on the inner face of the shingle;
- (3) reversely turned opposite edges for interlocking with adjacent shingles;
- (4) the turned bottom edge of each shingle forming a gutter;
- (5) a fastening tab extending from an upper corner of the shingle;
- (6) a drain slot disposed in the gutter for draining water therefrom; and
- (7) the ridges on the inner face of the shingle spacing the top edge of the lower shingle from the inner surface of the shingle so that moisture of condensation can travel into the gutter.

All of the above elements are present in the shingle actually manufactured by the plaintiff corporation and in fact the shingles currently manufactured and sold by plaintiff corporation (PX 2) are substantially identical to the shingle as illustrated in the Korter patent drawings. The only element of the above list which distinguishes the disclosure of the patent in suit from the disclosure of the earlier and finally rejected application of Korter is element No. 6, the "drain slot" formed in the gutter. This drain slot is shown at 21, Figs. 1 and 3 of the Korter patent in suit, and no such drain slot is disclosed in the earlier application. This drain slot is the basic and essential feature of the patent in suit. See page 1, column 1, lines 17 to 19, inclusive.

“Fig. 3 is a fragmentary perspective view of one corner of the shingle showing the drain slot *which forms the basis of this invention.*” (Emphasis ours).

Defendants’ Alleged Infringing Device

Appellants’ shingle (PX 3) contains no “drain slot” formed within the gutter. While there are numerous other differences of a lesser nature (Tr. 229, 231), the absence of a drain slot is the major distinction between the shingles of Korter’s patent and defendants. It may be admitted, *arguendo*, that appellants’ shingle is substantially similar to the shingle disclosed in the finally rejected and abandoned Korter application Serial No. 776,332 in that any water collecting in the gutter at the lower end is drained from the open ends of the gutter.

SPECIFICATIONS OF ERROR

Appellants rely upon each of the eleven specifications of error assigned by them with the statement of points on appeal (Tr. 305).

There are two main defenses in this suit:

- (1) Noninfringement, and
- (2) Invalidity of the Korter patent.

The first ten of the specifications of error relate to these two defenses while the eleventh specification of error relates to the adjudication and findings that appellant Harry X. Bergman is personally liable for any infringement of the Korter patent.

Questions Presented

1. Is the patent entitled to the doctrine of equivalents where the documents relating to the prosecution of the patent in the Patent Office establish that only by the inclusion in the specification and claims of a new element (drain slot) was the applicant able to obtain allowance of the patent? The accused structure does not have that element (drain slot).
2. Does the accused structure infringe when it does not have an element (drain slot) expressly called for in the claim of the patent?
3. Did the District Court apply the required standard of invention in holding valid a patent which is for an assembly of old elements that produce no new or unobvious result?
4. If the patent is valid and infringed, is an officer of a defendant corporation personally liable when the officer has done nothing beyond the scope of his duties?

PROPOSITIONS OF LAW RELIED UPON AS DETERMINATIVE OF SCOPE OF PATENT

1. When a patentee on the rejection of his application inserts in his specification, in consequence, limitations and restrictions for purpose of obtaining his patent, he cannot after he has obtained it, claim that it shall be construed as it would have been if such limitations and restrictions were not contained in it.

Shepard v. Carrigan, 116 U.S. 593.

2. Where a patentee has so modified his claim in obedience to the requirements of the Patent Office, he cannot have for it an extended construction which has been rejected by the Patent Office; and, in a suit on his patent, his claim must be limited, where it is a combination of parts, to a combination of *all* the elements which he has included in his claim as necessarily constituting that combination.

Morgan Envelope v. Albany Paper Co., 152 U.S. 425.

3. Where a patentee has narrowed his claim in order to escape rejection, he may not "by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amounted to disclaimer."

Smith v. Magic City Kennel Club, 282 U.S. 784.

4. Where an applicant for a patent to cover a new combination is compelled, by the rejection of his application by the Patent Office, to narrow his claim by the *introduction of a new element*, he cannot after the issue of the patent broaden his claim by *dropping* the element which he was compelled to include in order to secure his patent. If dissatisfied with the rejection, he must pursue his remedy by appeal, and where in order to get his patent he accepts one with a narrower claim he is bound by it. It is not for the Court to inquire whether the examiner was right or wrong in rejecting the original claim.

Smith v. Magic City Kennel Club, *supra*.

5. The proceedings in the Patent Office are an important aid in interpreting the claims of a patent.

Lensch et al v. Metallizing Co., 39 Fed. Sup. 838.

6. The improver is not like a pioneer and is entitled only to a narrow range of equivalents. Where he has been specific in matters of number, form, structure, relationship and function of the element of his claim as the condition of the art required him to be, he cannot be permitted to depart from the plain meaning of the language he has adopted or claim for such language broad and generic construction.

Boyd v. Janesville Hay Tool Co. 158 U.S. 260;

D. & H. Electric Co. v. M. Stephens Mfg. Inc., et al, 108 USPQ 27.

ARGUMENT

In addition to the other errors of law and fact here involved, the learned trial Judge erred in holding that "There is no law in patent cases. A patent case is a question of fact," (Tr. 75), and by failing to follow either in his findings or conclusions of law the tests prescribed by the Supreme Court of the United States and adopted by this Court in *Kwikset Locks, Inc. v. Hillgren*, 210 Fed. 2d 483.

Had the trial Court applied these principles, it could not have avoided reaching the following conclusions:

(1) That every element of the claim which the Court upheld is found in the prior art except the drain slot adjacent the corner of the shingle and that the addition of this drain slot was the only new or unexpected result disclosed or claimed by Korter. Whether this would constitute invention is another question which we do not now discuss.

(2) That the defendants' accused structure omits the very element which constituted Korter's alleged invention and does not obtain the alleged new and unexpected results by means of any slot.

(3) That inasmuch as the accused structure neither includes the new element, the inclusion of which enabled Korter to obtain his patent, nor the unexpected result which Korter claimed from this new element, it does not infringe.

Furthermore, the learned District Judge failed to "scrutinize combination patent claims with a care proportioned to the difficult and improbability of finding invention in an assembly of old elements," which is enjoined in *Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147.

While invention may be a question of fact, there are legal standards which must be applied to determine whether or not the invention in fact exists. It is not invention to discover that water will flow through a hole and if one hole is not large enough to take care of the flow or any detritus which might tend to choke a hole, the problem can be taken care

of either by enlarging the hole or providing another hole. It would not take a mechanic of more than ordinary skill to discover this. In fact, any school boy is aware of this situation.

The Decision Below

Since the Court below did not see fit to write an opinion in support of its decision for plaintiff, we are left merely with the Findings of Fact and Conclusions as a possible explanation or motivation for the Court's decision. However, an examination of the Findings is of no assistance because they are completely devoid of any detail or explanation of the alleged invention, the patent, the accused shingle, the prior art or a comparison of the patent and accused shingle with the prior art devices. The Findings are merely conclusions of law and should carry little, if any, weight.

We believe that four major errors of law led the District Court to the conclusion that the Korter patent was valid and infringed:

1. The District Court held the Korter patent valid although there was no finding that the old elements which make up the device perform any additional or different function in the combination than they perform out of it, or that any new result was effected which was the joint product of the various elements.

2. The District Court made no findings as to what was in the prior art or what the Korter invention was, but merely adopted plaintiff's general conclusions

and arguments so that the findings are argumentative and have little value, if any, to support the Court's conclusion of validity of the Korter patent.

3. The District Court ignored the file wrappers of the prior abandoned Korter patent application and the patent in suit and failed to give any effect whatever to estoppel arising from these file wrappers which precluded the claim of the Korter patent being construed so as to include the accused shingle.

4. The District Court erred in giving the Korter patent a range of equivalents sufficiently broad to cover the accused shingles which differ from the patented shingle in their construction, operation and result.

The Findings

This is a case in which the decision depends upon documentary evidence, i.e., patents and file wrappers, and an observation of witnesses and their creditability is of little importance. There is no dispute as to the evidentiary facts and this Court is in as good a position as the District Court to examine the relevant evidence.

Kemart Corp. v. Printing Arts Research Lab.,
(9th Cir. 1953) 201 F. 2d 624, 627;

Kwikset Locks v. Hillgren, supra.

The decision of this Court can and should be based upon the interpretation of written documents and a construction of undisputed statements of the pat-

entee before the Patent Office and, therefore, the matter is as open for consideration by this Court as it was to the Court below.

We repeat that a most significant omission of the Findings is a failure to state what the invention of the Korter patent was. As this Court recently said in *Kwikset Locks, Inc. v. Hillgren*, *supra*, page 291:

“* * * The Supreme Court further requires that in order for a combination patent to be upheld, *there must be a specific finding that the old elements which made up the device perform an additional and different function in combination than they perform out of it.* No such finding was made in the case at bar. Nor do we believe that the District Court applied the strict standard or the close scrutiny to this combination patent required by the Supreme Court.” (Emphasis added).

The omission of the Findings on this particular point is significant because of the concentrated effort made by the plaintiff below to divert the attention of the Court from the drain slot and to create the false impression that the Korter invention was of a much greater scope and embraced a new and basic principle. It may well be that the lower Court was influenced by certain statements and representations made by the plaintiff in this regard, and as a result thereof the Court found the patent valid and infringed.

The Korter Patent Involves No New "Principle"

During the trial, plaintiff's expert witness, Mr. Max C. Richardson, testified (Tr. 84) that the drawing, plaintiff's exhibit 5, entitled "Principle of Korter's Invention," correctly illustrated "the intent and actual operation of Mr. Korter's shingle." This drawing shows only how condensation is drained from the underside of the shingle.

Relative to the same matter, Mr. Richardson testified variously further as follows:

"Now, attention should be called to Figure 4 and Figure 6 of the patent. In Figure 6 it is to be noted that 19 is the upper edge of a lower shingle, and that the small section above it as shown where the section is on Figure 4 is the cross-section of the lower edge of the upper shingle, showing that the corrugation 12 spaces the upper shingle from the curved top edge of the lower shingle in order that moisture hanging to the underside of the upper shingle can travel along the under shingle and into the gutter 20. *That is important and, as far as I know, not found in the prior art.* And the combination of that means, together with means for surely draining the water from the gutter onto the lower shingle, is the improved combination of Mr. Korter." (Emphasis added). (Tr. 88).

The Court asked Mr. Richardson a very pointed question (Tr. 297):

"The Court: Do you find any shingle in the previous art which had such a loose combination that it would have acted to withdraw the

water of condensation off the inner surface of the roof?

“A. Of course, it is difficult not to read a prior art with hindsight. When we go into matters of this kind, * * *.

* * *

“The Court: But you find nothing in any of these prior patents that are here in evidence—

“A. I find nothing in any of the prior patents except Belding that even recognizes the problem.

“The Court: And that solves it in a different way?

“A. That solves it in a different way.”

Further, on cross-examination, Mr. Richardson testified (Tr. 302):

“Q. Is it then your position that there was never a drain slot before Korter?

“A. There never has been a combination of the improvement of a method to drain condensation from the underside of a shingle.”

The above testimony could very well have impressed the trial Court with the idea that Korter's invention resided in the provision of a space between the lower edge of the upper shingle and the curved top edge of the lower shingle whereby condensation may flow downwardly along the underside of the shingle and into the gutter.

However, the fact is that the principle thus asserted for Korter's invention and illustrated in plain-

tiff's Exhibit 5 was inherent in the structure shown in the Miller patent No. 2,243,256 (PX 31). In the drawing of Appendix A there is reproduced the drawing of plaintiff's Exhibit 5 as well as Figs. 2 and 9 of the Miller patent. By reference to this drawing, it will be observed that each and every one of the functions illustrated and asserted to be the principle of Korter's invention are found to be inherent functions in the operation of the Miller shingle. While Miller does not, in his specification, refer specifically to the matter of *condensation* occurring on the underneath side of his shingle and draining downwardly into the gutter, it will be obvious that should any condensation occur on the underneath surface, it would inherently drain downwardly into the gutter. The specification does refer to the free drainage of rain water from the interlocking connections between the shingles. Attention is directed to the specification, page 1, column 1, lines 9 to 18, inclusive, and page 2, column 2, lines 64 to 73, inclusive. Whether the water which accumulates in the gutter is driven in from the rain and wind on the outside or comes from condensation occurring on the inner surface of the shingle is obviously immaterial. Referring to Fig. 9 of the drawing of Appendix A, it will be observed that the lower edge of the upper shingle A is spaced from the curved top edge 9 of the lower shingle by the thickness of the head of the nail 15 extending therebetween. Accordingly, any condensation which might occur upon the underneath side of the shingle, as indicated by

the beads of water M, may flow downwardly on the shingle into the gutter, as shown at N and from whence it may drain outwardly through the open ends of the gutter indicated at O in Fig. 2.

It is irrelevant that Miller does not refer to the matter of drainage of condensation. In this regard, Chief Judge Clark, 2nd Circuit, said:

“Without going into other cited patents of a cumulative effect here, we think it clear, therefore, that this Gentzel patent consists of a combination of elements, all of which were fully disclosed prior to its issuance. It is irrelevant that the inventors of prior devices failed to describe or appreciate all of their advantages (in this case, the prevention of undesirable heating of the frame rods). Consolidated Bunging Apparatus Co. v. Metropolitan Brewing Co., 2 Cir., 60 F. 2d 93, 97. It is enough that prior patents disclosed all the elements of plaintiff’s patent and in fact, lacking only slight modification, the very combination of elements contained in plaintiff’s invention. See Concrete Appliances Co. v. Gomery, 269 U.S. 177, 185; Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 91, 51 USPQ 272, 275; Wrightway Engineering Co. v. Melard Mfg. Corp., 2 Cir., 219 F. 2d 392, 104 USPQ 223. * * * .”

Gentzel et al v. Manning, 230 F. 2d 341, 108 USPQ 353.

With reference to the matter of drainage from the gutter of the Miller shingle, Richardson on direct

examination was asked by plaintiff's counsel (Tr. 260):

“Q. Does Miller show a drain slot disposed in the gutter of the shingle?

“A. No, sir.”

Certainly, Miller does not show a cut-out drain slot similar to the cut-out drain slot 21 such as is shown by Korter in the patent in suit, but, nevertheless, Miller does show open ends on his gutter, as indicated in Fig. 2 of the drawing of his patent which is substantially identical with the open ends provided on the gutters of appellant's shingle.

Now, did Mr. Richardson in his testimony mean, because Korter provided a cut-out drain slot in his gutter rather than to permit the water to flow freely from the open end of the gutter, that Korter had invented a new principle? If he did, then he was obviously in error.

The Patent Office Rejected Claim 10 Directed Broadly to the Spacer Ribs for Facilitating Drainage of Condensation

The testimony of Richardson is all the more glaring when compared with the record history of the application which Richardson ignored. The file clearly shows that the Patent Office rejected the suggestion that Korter was entitled to patent protection for the spacer ribs 12. Attention is directed to the record regarding claim 10 which was submitted by the amendment dated March 19, 1951, page 10 of

the file wrapper (DX 29). For convenience this claim 10 is reproduced as follows:

“10. An aluminum shingle of rectangular shape having flat seams along the lateral edges thereof and having a backwardly turned half-round gutter along its butt end, said gutter having a reversely curved side, said gutter having a drain opening near the end thereof, the tip of said shingle having a shape similar to said butt end and turned toward the weather side of the shingle, said shingle having grooves formed therein forming spacers between the underside of the shingle and the top side of the interlocked gutter and tip seams.”

This claim calls for “said shingle having grooves formed therein forming spacers between the underside of the shingle and the top side of the interlocked gutter and tip seams,” the purported purpose of this particular feature of the invention being to provide for passage of condensation along the bottom side of the shingle past the upper edge of the underneath shingle and into the gutter from whence the condensation can flow outwardly through the drain slot. In the Remarks accompanying claim 10 and beginning on the bottom of page 11 of the file history, the following statement is made:

“In the new claim 10 is brought out the fact that the shingle has flat seams at each side and similar special seams at the tip and butt ends and that the grooves 12 form spacers which rest on the interlocked members 19 and 20. This provides a way for condensation to flow down the

underside of the shingle into the gutter from which it escapes through the drain hole 21."

This claim was promptly rejected in the next Office action by the Examiner dated December 6, 1951, in the following words:

"Claim 10 is rejected as unpatentable over Birch in view of Slaughter for the same reasons cited against claim 8. In Birch, the grooves 22 form spacers or channels on the underside of the shingles so that moisture on the said underside will drain into the gutter substantially for the same purpose as applicant's grooves." (Copy of Birch attached hereto as Appendix B.)

The applicant acquiesced in this rejection by the Examiner and this claim was promptly cancelled from the application, and no claim of comparable scope was ever submitted thereafter in the application.

It is quite obvious that the principle portrayed in plaintiff's Exhibit 5 was not of Korter's invention and that it was seized upon to distract attention from the miniscule contribution actually made by Korter.

The Court should note the extreme difficulty experienced by attorneys for Korter in obtaining allowance of the claim in the patent in suit. The history of the two applications (DX 28 and DX 29) are outlined as follows:

Application, Serial No. 776,332 (DX 28), Filed September 26, 1947.

Rejected, file wrapper page 9, November 24, 1948

- Amended, file wrapper page 10, February 24, 1949
- Amended, file wrapper page 14, September 9, 1949
- Rejected, file wrapper page 16, May 10, 1950
- Amended, file wrapper page 17, October 2, 1950
- FINAL rejection, file wrapper page 19, April 4, 1951
- Amended, file wrapper page 20, April 18, 1951
- Rejected, file wrapper page 23, April 24, 1951
- Appeal to Board of Appeals, file wrapper page 24, May 23, 1951
- Appeal Brief, file wrapper page 25, July 18, 1951
- Examiner's statement, file wrapper page 33, September 7, 1951
- Decision of Board of Appeals, file wrapper page 35, July 24, 1952
- Appeal to U. S. District Court, file wrapper page 40, December 5, 1952
- Appeal Dismissed, file wrapper page 40, March 13, 1953
- Application, Serial No. 137,566 (DX 29), Patent No. 2,631,552, Filed January 9, 1950*
- Rejected, file wrapper page 8, November 2, 1950
- Amended, file wrapper page 9, March 19, 1951
- Rejected, file wrapper page 13, December 6, 1951
- Amended, file wrapper page 15, June 6, 1952
- Amended, file wrapper page 19, October 7, 1952
- Interview acknowledged, file wrapper page 21
- Amendment, file wrapper page 33, October 10, 1952
- Interview acknowledged, file wrapper page 35
- Amendment, file wrapper page 56, December 1, 1952

Interview acknowledged, file wrapper page 57
 Rejected, file wrapper page 65, January 12, 1953
 Amendment, file wrapper page 67, January 15
 1953

Interview acknowledged, file wrapper page 68
 Amendment, file wrapper page 74, January 28
 1953

Interview acknowledged, file wrapper page 75
 Amendment, file wrapper page 78, February 9
 1953

Interview acknowledged, file wrapper page 79
 Particular attention is directed to the fact that

the record acknowledges at least six personal interviews with the Examiner, all within a space of six months. A similar record of wearing down the resistance of the Examiner drew a strong criticism from Chief Judge Clark in the case of *Gentzel v Manning*, supra:

“* * * Of at least equal persuasiveness are the tortuous progress of these patents through the Patent Office from 1935 to 1942 and the many emendations of statement, especially in the second patent, made to meet the objections of examiners—a classic example of what Judge Learned Hand has called ‘the antlike persistency of solicitors’ which overcomes ‘the patience of examiners, and there is apparently always but one outcome.’ See *Lyon v. Bob*, D.C.S.D.N.Y. 1 F. 2d 48, 50, reversed on grounds not here apposite 2 Cir., 10 F. 2d 30.”

Korter's Sole Contribution Was a "Drain Slot"

Korter's sole contribution to the metal shingle art resides in the provision of a cut-out "drain slot" in the gutter at the lower end of the shingle. This is clearly established beyond any question of doubt by the specification of the Korter patent itself. For example, in the fore part of the specification, page 1, column 1, lines 17 to 19, inclusive, the following statement is made:

"Fig. 3 is a fragmentary perspective view of one corner of the shingle showing the drain slot which forms the basis of this invention."

A few lines further, the drain slot is further emphasized thus:

"Fig. 4 is a fragmentary vertical section through an overlapping joint showing the purpose of the drain."

Again, in lines 23 to 25, column 1, further reference is made thereto thus:

"Fig. 5 is a fragmentary section along the line 5-5 in Fig. 4 through the butt end of the shingle and passing through the drain slot."

Later on in the specification, page 1, column 1, beginning with line 54, the drain slot is further described.

"* * *, I have provided each gutter edge 16 with a drain slot 21 near the corner 22 of the shingle. Obviously, more slots 21 may be employed without departing from the spirit of this invention. * * * The purpose in having the drain slot 21 near the corner 22 is to keep it as far as

possible from the joints in the next lower course.”

In view of the repeated references to the cut-out drain slot 21 made throughout the specification of the patent and in view of the clear and unambiguous portrayal in the drawings, it is inconceivable that the term “drain slot” as found in the claim permits of any other interpretation.

It is a general rule of patent law that the protection furnished by a patent and the extent of the grant, are measured by the claims, which measure or define the invention. The patentee disclaims or waives everything not covered by the claims, and is bound by limitations therein; and he and the Courts are bound by the language thereof.

“The protection furnished by a patent and the extent or scope of the grant, are measured and limited by what is set forth in the claims on which it was granted. Accordingly, under the judicial decisions on the question, the claims measure, determine the invention patented or, under other circumstances, define the invention patented, measure, determine, define, or control the scope thereof, define the extent thereof, or mark its boundaries, or limit the rights of the patentee, or measure his property rights and his right to relief. The boundaries established by the patentee may be neither extended nor shortened to meet the exigencies of a particular situation.

“A patent in litigation must stand on the

original claims and specifications, or it cannot stand at all, and each claim must stand or fall as itself sufficiently defining the invention independently of the other claims.

“Everything not covered by the claim or claims is disclaimed, or waived, and, according to the several decisions on the question, is open to the public, and the patentee, or one claiming under the patentee, is bound by limitations contained therein, notwithstanding the general rule, stated *infra* subdivision (c) of this section, requiring the broadest interpretation which the terms of the claim will reasonably permit. A claim can never be given a construction broader than its terms in order to cover something which might have been claimed but was not.

“If the language of the claims is clear and distinct, the patentee is bound by the language he has employed, and may not claim anything beyond them. Courts must take claims as they find them, and may not rewrite them, but are bound by the language chosen by the inventor in framing his claims, and may not add to or detract from, and the claims matter not expressly or necessarily implied, or enlarge the patent beyond the scope of that which the inventor claimed and the Patent Office allowed, even though the patentee may have been entitled to something more than the words he has chosen will include.”

69 C. J. S. 680-685 (4 full pages of citations listed).

As was further stated by the Supreme Court of the United States in *Universal Oil Products Co. v. Globe Oil Refining Co.*, 322 U.S. 471:

“The claim is a measure of the grant. *Smith v. Snow*, 294 U.S. 1. The claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent.”

Admittedly, an express limitation in a claim may be ignored, or given a broad interpretation when a perusal of the file history shows that its inclusion in the claim was not necessary to an allowance of the claim or required by the Patent Office or by the prior art. However, such were not the circumstances in the present case since the file history indicates that it was necessary to include a specific reference in the claim to the “drain slot” 21 in order to distinguish the Korter structure over the prior art cited thereagainst by the Examiner during the prosecution of the application.

There can be no doubt but that it is entirely proper to refer to the file wrapper of a patent application for the purpose of determining the scope of the claims as granted. This procedure has been approved by the Supreme Court of the United States and followed in this Circuit.

“If there be any ambiguity or if the true scope of applicant’s invention is not clear, our Ninth Circuit Court of Appeals has in effect held that reference may be made to the file wrapper

and arguments. Fullerton Walnut Growers' Ass'n v. Anderson-Barngrover Mfg. Co., 166 F. 433, 452. See also Lektophone Corporation v. Rola Co., 27 F. (2d) 758, affirmed 34 F. (2d) 764. This we believe to be the proper interpretation of the decision of the Supreme Court in Keystone Driller Co. v. Northwest Engineering Corp. (1935), 294 U. S. 42 (24 U.S.P.Q. 35). (For a discussion of the rule in this circuit and in other circuits, see 'File Wrapper Estoppel' by Vern L. Oldham in 20 Journal of the Patent Office Society 115 [1938] and case note in 8 George Washington Law Review 871 [March, 1940].)''

Lensch et al v. Metallizing Company of America et al, supra.

The original application, Serial No. 776,332 (DX 28) referred to in the first paragraph of the patent in suit, did not incorporate any drain slot in the gutter of the shingle. Aside from the cut-out drain slot, the metal shingle disclosed in the drawing and specification of that original application was identical with the shingle disclosed in the patent in suit. This was admitted by Korter (Tr. 152). As the file history of the first patent application shows, the inventor was unable to differentiate the shingle shown herein over the prior art patents. Following final rejection of all claims, an appeal was then taken to the Board of Appeals which affirmed the Examiner and, as mentioned above, the application was ultimately abandoned. Now Korter asks that the claim of his patent be construed so broadly as

to cover the construction which was abandoned in his first application.

Usage of Term "Drain Slot" in the Claim was Intentional

Many of the claims submitted during the prosecution of the second application called merely for a "drain opening" in the gutter and the Examiner promptly rejected all such claims on the basis that such prior art patents as Miller and de Sincay disclosed drain openings. The claim as ultimately allowed stipulated a "drain slot" instead of a drain opening and all of the various arguments submitted for the allowability of the claim also referred specifically to a "drain slot".

In the amendment which submitted the claim which was finally allowed, emphasis was placed upon the "cut away drain slot at the bottom of the shingle which is disposed adjacent a corner thereof for draining water from the shingle." (See file wrapper, DX 29, page 23.)

In the remarks filed under date of October 9, 1952, beginning on page 36 of the file wrapper, the following statement is made:

"Furthermore, none of the shingles of the prior art provide a shingle having the body of the shingle lying in the same plane wherein all four sides are curved as set out, and there is a cut-away drain slot disposed at the *bottom* of the curved edge portion of the shingle and *adjacent a corner thereof* so that water will drain, not into the joint of the shingle but inwardly and over

the face of the next lower shingle and hence downwardly over the roof structure. This drain slot and its position is an important structural feature of applicant's aluminum shingle and cooperates with the interlocking curved edge portions and gutters as called for in the claim, so as to provide the improved shingle which has been a revolutionary development in the art of metal shingles."

The importance of the "cut-away drain slot disposed at the bottom of the shingle and spaced from the corner" was again emphasized in the remarks dated December 1, 1952 (see file wrapper, page 58).

Of particular interest is the affidavit which was filed by Mr. E. B. Birkenbeuel, patent attorney for the inventor, dated December 8, 1952, and appearing at pages 72 and 73 of the file wrapper. Particular attention is directed to the last paragraph of this affidavit, reading as follows:

"(4) Further, affiant considers it is manifest by utilizing the aforesaid novel interlocking shingle structure on all four sides of the shingle and providing a drain slot in the lower edge flap which slot is so spaced or offset from the side edges of the shingle structure that there is substantially no possibility of water permeating through a roof structure fabricated from the aforesaid aluminum shingle structure."

**Korter Never Intended the Term "Drain Slot" to be
Synonymous with the Term Such as "Open Gutter End"**

Korter on cross-examination (Tr. 160, 161) testified as follows:

"Q. Are the drain slots 21 shown in your patent necessary to accomplish the result which your patent teaches? Do you have a copy of your patent before you?"

"A. Yes.

"Q. If there were no drain slots such as 21, would a shingle function the same as your shingle?"

"A. As I explained in the early conversation, we had openings on the ends to act as drain slots, but they were not adequate in all operations. That is why I included this new improved drain slot to take care of all conditions."

The inventor previously testified (Tr. 150) to the effect that the openings provided at the ends of his earlier shingles tended to clog up because of wind and dust, which was the reason for his putting the drain slots in the gutter.

Moreover, Korter's testimony was corroborated by plaintiff's expert, Mr. Max C. Richardson, who testified on direct examination (Tr. 260) that Miller (DX 31) did not show any drain slot disposed in the gutter.

"Q. Does Miller show a drain slot disposed in the gutter of the shingle?"

"A. No sir."

It is clear, therefore, that the inventor was well aware of the fact that the claim as allowed to him by the United States Patent Office was positively and definitely restricted to a combination including a drain slot and that the claim was not worded broadly enough to cover a combination omitting a drain slot but providing instead merely an open-ended gutter.

Korter Cannot Resort to the Doctrine of Equivalents to Recapture That Which Was Required to be Given Up in Order to Obtain a Patent

The law on file wrapper estoppel is so fully developed and virtually unanimous, no lengthy discussion is deemed necessary. Reference is made to only a few leading cases, including *Smith v. Magic City Kennel Club*, supra. The facts in this last-mentioned case are briefly summarized as follows: The patentee owned a patent upon apparatus for use in connection with dog races and more particularly to the mechanism for conveying the rabbit lure around the track. The patent contained a number of claims, all of which were expressly limited to a combination comprising a conveyor mechanism with an arm extending horizontally outwardly over the race track and a lure or quarry mounted on the outer end of the arm, with a wheel engaging the ground rotatably supporting the outer end of the arm.

The patentee brought suit against another party alleging infringement of his patent by reason of another apparatus consisting of a conveying mechan-

ism extending around a race track with an arm extending horizontally over the track and supporting a rabbit or other lure on the outer end of the arm. No wheel was provided in this latter apparatus for supporting the outer end of the arm upon the ground as was incorporated in the patented device.

The Supreme Court of the United States noted that the patentee originally asked the United States Patent Office for the allowance of broader claims but such claims were rejected on the basis of prior art patents and were subsequently either amended or cancelled. All of the claims which were ultimately granted by the Patent Office included an express stipulation in each calling for the wheel rotatably mounted near the end of the arm. There is no question raised whatsoever but that the rigid arm structure omitting the wheel performed in substantially the same manner as the patented device having the ground-engaging wheel at the outer end of the arm but, nevertheless, the Court held that the terms of the claims were binding upon the patentee.

“The case, in our opinion, thus calls for the application of the principle that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he can not after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. *Shepard v. Carrigan*, 116 U. S. 593, 597.

“As this court said in *I.T.S. Rubber Company v. Essex Rubber Company*, 272 U. S. 429, 443: ‘If dissatisfied with the rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it. *Shepard v. Carrigan*, supra, 597; *Hubbell v. United States*, 179 U. S. 77, 83. Whether the examiner was right or wrong in rejecting the original claim, the court is not to inquire. *Hubbell v. United States*, supra, 83. The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. *Sargent v. Hall Safe & Lock Company*, 114 U. S. 366; *Shepard v. Carrigan*, supra, 598; *Hubbell v. United States*, supra, 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. *Morgan Envelope Company v. Albany Paper Company*, 152 U. S. 425, 429.’

“The petitioner resorts to the doctrine of equivalents, insisting that the rigid horizontal arm of the respondents is to be treated as the equivalent of the arm of the patent, and that the limiting specifications of the claim may be ignored. What has already been said disposes of this contention, for where a patentee has nar-

rowed his claim, in order to escape rejection, he may not 'by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to disclaimer.' *Weber Electric Company v. Freeman Electric Company*, 256 U. S. 668, 677, 678; *I.T.S. Rubber Company v. Essex Rubber Company*, *supra*."

Smith v. Magic City Kennel Club, *supra*.

The above case was followed and affirmed by the Ninth Circuit in *Lensch v. Metallizing Company of America et al*, *supra*. Additional Ninth Circuit cases along the same lines are the following:

"In view of the prior art and the history of claim 3 of the patent, the patentee is only entitled, at most, to the precise device mentioned in the claim. *Boyd v. Janesville Hay Tool Co.*, 158 U. S. 260. As so construed, claim 3 of the patent is not infringed by appellant and it therefore becomes unnecessary to discuss further or decide the question of the validity of claim 3 of the patent in suit."

Deats Sash and Door Company v. George L. Eveleth and Arcadia Sash and Door Company, Ltd., 9 Cir., 22 USPQ 211, 212; 72 F. (2d) 100, decided July 10, 1934.

"* * * The file wrapper contains evidence that the inventor understood this element of his claim in the narrower sense. During the proceedings before the Patent Office, two of the claims were rejected on Anderson, No. 811,812, and the inventor undertook to differentiate An-

derson's invention, saying: 'Anderson . . . does not show a packing having a flange clamped in the sleeve.' (Anderson employed a U packing fitted into a seat similar to the one found in appellants' device.) While it is the rule of this circuit that admissions made by the applicant to the examiner are not to be used to narrow the scope of his claim unless he has made changes in his application pursuant to the examiner's suggestions, yet the proceedings may be used to aid in construing the claim."

Warren Bros. Co. v. Thompson, 9 Cir., 293 F. 745.

"We conclude that the allegedly infringing device employs as one of its elements a packing different from that described in Lanninger, and that the two packings do not function in the same way. Appellees attempt to minimize the differences, but we think they are sufficiently substantial to spell noninfringement. Lanninger's combination is not entitled to any broad range of equivalents."

Schnitzer et al., doing business as Alaska Junk Company v. California Corrugated Culvert Company et al., 140 F. (2d) 275, 60 USPQ 222, 223 (1944).

In a recent case, *D. & H. Electric Co. v. M. Stephens Mfg., Inc.*, supra, this Court held that there was no infringement, even though validity was not contested, on the ground that ribs in the accused device varied from one to five degrees from perpendicular

and the claim called for such ribs as being “substantially at right angles.” The Court referred to the file wrapper of the patent in suit to determine that the novel feature claimed by the invention was the right angular position of the ribs. The Court said, page 29:

“Having asserted the novelty of the right angle principle in order to secure the patent appellant cannot now expand his coverage to include other claims which were denied him in the proceedings before the Patent Office. This is simply the exercise of the doctrine of ‘file wrapper estoppel’—the gravamen of which is that an applicant who acquiesces in the rejection of his claim, and accordingly modifies it to secure its allowance will not subsequently be allowed to expand his claim by interpretation to include the principles originally rejected or their equivalents.”

Likewise, Korter should not be permitted to expand his claim to include that which was originally rejected. The abandonment of his first application (DX 28) and his cancellation of claims in the application of the patent in suit (DX 29) were express disclaimers of any drainage means such as open corners at the ends of the gutter like those of the accused shingle.

As the Court of Appeals for the Seventh Circuit recently said in *Kromer v. Reigel Textile Corp.*, 227 F. (2d) 741, 107 USPQ 317, 319, 320:

“In our view, it is a clear case for the applica-

tion of the doctrine of file wrapper estoppel, which the District Court did not discuss or refer to. * * * In order to hold infringement it would be necessary to ignore an essential element of the claim, the insertion of which enabled plaintiffs to procure its allowance. It would also result in a resurrection of the claims rejected by the examiner in view of the prior art.”

This Court further held in *D. & H. Electric Co. v. M. Stephens Mfg. Inc., et al*, supra, that file wrapper estoppel applies even though the Patent Office erroneously rejected claims which were subsequently cancelled.

“Nor are we impressed by appellant’s reliance upon the feature embodied in the greater helical angle of the ribs of the coupling device, as compared with the helical angle of the thread of the conduit. Examination of the prior art considered by the patent examiner reveals that the principle of joining threads or ribs of a greater helical angle with those of a lesser helical angle, or the joining of unfitting threads in order to secure a locking fit, is not new. In any event, the inventor’s claim on this score was rejected with his acquiescence, and by reason of the file wrapper estoppel he cannot now claim it, even though the action of the patent office in rejecting it was erroneous.”

In view of the established law on the subject, it is clear that the claim of the Korter patent must be restricted by file wrapper estoppel to a shingle structure including a “drain slot” in the gutter thereof.

It matters not as to whether the Patent Office erroneously rejected the broader claims omitting reference to the drain slot. Suffice it that the broader claims were cancelled and the narrower one accepted, and the patentee is thereby bound. The patentee cannot by resort to the doctrine of equivalents now contend that the defendants' shingle, which has no drain slot, infringes, and especially not when the defendant employs an open-ended gutter in exactly the same manner as employed in the prior art.

INVALIDITY

Propositions of Law Relied Upon in Support of Invalidity

The Court should not stop with merely finding noninfringement but should also adjudicate the validity of the patent.

Sinclair & Carroll Co., Inc. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297.

To be patentable, a combination of individually old elements must be new and elements must cooperate to produce new and unexpected or unobvious result.

Powder Power Tool Corp. v. Powder Actuated Tool Co., CA 7th, 1956, 108 USPQ 155.

In order for a combination patent to be upheld, there must be a specific finding that the old elements which made up this device perform an additional and different function in combination, than

they perform out of it.

Kwikset Locks, Inc. v. Hillgren, supra.

Argument in Support of Invalidity

While it is inescapable that defendants' shingle voids infringement of the shingle claimed by the patent in suit for reasons previously mentioned, the Court should not stop merely with a holding of noninfringement. The Court should inquire further into the merits of the patent in suit and, it is urged, find the same invalid on grounds of lack of patentable invention. This is in accordance with the recommendation made by the Supreme Court in the decision of *Sinclair & Carroll Co., Inc., v. Interchemical Corp.*, *supra*. In this case the Court held:

“There has been a tendency among the lower federal courts in infringement suits to dispose of them where possible on the ground of noninfringement without going into the question of validity of the patent. *Irvin v. Buick Motor Co.*, 88 F. 2d 947, 951 (33 USPQ 60, 61); *Aero Spark Plug Co. v. B. G. Corp.*, 130 F. 2d 290 (54 USPQ 348); *Franklin v. Masonite Corp.*, 132 F. 2d 800 (56 USPQ 71). It has come to be recognized, however, that of the two questions, validity has the greater public importance. *Cover v. Schwartz*, 133 F. 2d 541 (56 USPQ 37, 188), and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent.”

As previously pointed out herein, and as admitted by the inventor at the trial in both direct examina-

tion (Tr. 150) and upon cross-examination (Tr. 160-161), and as further supported by the specification of the patent in suit as well as by allegations made during the prosecution of the application before the United States Patent Office, the alleged improvement invention in the present patent is restricted solely to the provision of a cut-out drain slot in the shingle gutter.

Such an improvement, if it is an improvement, is not entitled to a patent. As this Court said in *Berkley Pump v. Jacuzzi*, 214 F. 2d 785, f.n. 788:

“We emphasized the principle that a change in form, proportion or degree does not reflect patentable invention ‘even though changes . . . produce better *results*.’ (Emphasis supplied). In view of the cases we have noted we think that this principle must now be regarded as firmly imbedded in patent law.”

Certainly, there can be no invention in the idea that water will drain through a hole. It is not invention to increase the size of a hole where the prior hole would not permit the escape of the liquid sought to be drained, nor in providing two holes instead of one. The problem to be solved is so simple that any child would immediately perceive its solution. It is obvious that drain holes have been provided in gutters of buildings for transferring water from the gutter to a downspout as long as gutters have been in existence. While it may well be that no one has heretofore provided a drain slot in the

utter of a metal shingle before Korter, such an obvious expedient does not rise to the dignity of invention. Certainly no new or unexpected result was accomplished by Korter by the provision of such drain slot.

In the recent case of *Powder Power Tool Corp. v. Powder Actuated Tool Co.*, supra, the Court stated:

“To be patentable, a combination of individually old elements must be new, and those elements must cooperate to produce a new and unexpected or unobvious result.”

See also:

Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545, 37 USPQ 1;

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., supra.

In the further recent cases decided by the Court of Appeals for the Sixth Circuit, *Bobertz v. General Motors Corporation*, 107 USPQ 338, 228 F.2d 94, the Court had before it a patent relating to an automobile hood of transparent material. Aside from the fact that the hood was made of transparent material, the construction was substantially similar to conventional hood structures. The Court held the patent invalid on the grounds that no new results were accomplished in the patented structure:

“It seems almost idle to reiterate that quite a high standard of invention is now exacted to

sustain combination claims embracing old elements in a patent. This was made plain fourteen years ago in the opinion of the Supreme Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 90-92, 51 USPQ 272-275-276. Any lingering doubt as to the intention of the Supreme Court to require strict rather than liberal construction of combination claims was certainly dispelled by its opinion in *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corp.*, 340 U. S. 147, 154, 87 USPQ 303, 306, where the majority opinion concluded that the standard of invention used in the lower courts was less exacting than that required where a combination was made up entirely of old components."

All of the Elements of Korter's Claims Are Shown in the Prior Art

We particularly call attention to Miller patent No. 2,243,256 (Tr. 317, DX 31) which has all the elements called for in the Korter patent including the corrugations, as is readily seen from the following comparison between the parsed claim of the Korter patent and Miller:

Korter 2,631,552

Miller 2,243,256

"An aluminum shingle of rectangular shape, said shingle comprising

- a substantially flat sheet of metal of uniform thickness and the body of which lies substantially in the same plane,
- corrugations in said shingle spaced laterally of the shingle, said corrugations forming ridges on the inner face of the shingle,
- the lateral edges of the shingle being reversely turned on opposite faces of said shingle providing
- curved outer edge portions for interlocking the shingle with laterally adjacent shingles,
- the top and bottom edge portions of the shingle being reversely turned on opposite faces thereof, each of said top and bottom turned edge portions comprising
- shingle A
(Figs. 1 and 2)
- transverse ridges b', c', etc.
- *
- reversely turned flanges 5, 7, 9, 11
- edge portions of flanges 5, 7, 9, 11
- reversely turned flanges 9, 11

*While Miller shows corrugations b', c', etc., on the outer face, Birch et al shows corrugations 22a on the *inner* face identical to Korter.

- | | |
|---|--------------------------------------|
| 6. a half round portion,
one side of which is tan-
gent to the plane of the
shingle and
the other side of which
terminates in | rounded portions of
flanges 9, 11 |
| 7. a reversely curved por-
tion,
the turned bottom por-
tion forming | curved portion of
flange 11 |
| 8. a gutter and
the reversely curved
portion thereof being
engageable with a | under-turned flange
11 |
| 9. reversely curved top edge
portion of a
lower adjacent shingle
to form a close fit there-
between, | overtured edge of
flange 9 |
| 10. a fastening tab
integral with the shingle
and extending from an
upper corner of said
shingle for securing the
same to a roof structure,
and | tab t |

1. a drain slot
 disposed in the gutter of
 said shingle for draining
 water therefrom,
 said corrugation ridges
 on the inner face of the
 shingle adapted
 to space said reversely
 turned top edge portion
 of the lower adjacent
 shingle from the inner
 face of said shingle so
 that moisture can
 travel along the inner
 face of the shingle and
 into said gutter.”
- * * open corner 3
 P. 1, col. 1, lines 9-18;
 p. 2, col. 2, lines 64-73
- * * * upper shingle
 spaced from over-
 turned edge of
 flange 9 by the heads
 of the nails 15, 17

See also the schematic drawing attached hereto as Appendix C which further illustrates the Miller shingle and compares the essential features thereof with defendants' shingle. This comparison shows that all of the features of defendants' shingle are found in the prior art.

The British patent to de Sincay, No. 399, patented in 1869 (Tr. 348, DX 38), also shows a metallic shingle of the interlocking type having reversely turned opposite edges and an open corner K for draining “any water which may have penetrated to a certain extent between the tiles under the action of

**Miller's corner 3 is not a drain slot like Korter's slot 21 but substantially identical with the open corner of the accused shingle.

*Corrugations on the inner face as taught by Birch et al, Fig. 14, provide spacing identically as called for.

high wind will run off to the lower corner of the tile and so on to the roof" (specification, p. 4). This means that any water on the underside of the de Sincay shingle, such, for instance, as water of condensation, would run down through the shingle to the opening K and then on to the face of the next lower shingle. Therefore, this shingle operates inherently in the same way and for the same purpose as Korter's patented shingle.

Other very old patents which show flat, rectangularly shaped metal shingles having reversely turned opposite edges adapted to lock into adjacent shingles, nailing tabs, and open corners through which any water that got under a shingle would naturally drain, are Crawford No. 553,514 (Tr. 313, DX 30), the two Lewando patents Nos. 124,963 and 140,928 (Tr. 323, 326, DX 32, 33), Clawson No. 1,026,202 (Tr. 329, DX 34), Slaughter No. 220,181 (Tr. 333, DX 35), and Cusack No. 303,921 (Tr. 337, DX 36).

It should be noted that the Crawford patent was not cited by the Patent Office against the application which matured into the patent in suit although it was cited against the abandoned Korter application (DX 28).

Attached hereto as Appendix C is a schematic drawing comparing the structural elements of defendants' shingle with a prior art shingle, for example, that shown by Miller, patent No. 2,243,256, attention being directed by suitable legends to the

various elements as called for in the claim of the Korter patent. It will be obvious that each of the elements called for by Korter finds a full and complete response in the prior art and hence the Korter patent must be declared invalid.

Commercial Success Cannot Save an Invalid Patent

In the present case some evidence of commercial success of the plaintiff corporation was admitted (Tr. 155). However, where invention is lacking, commercial success cannot save an invalid patent. The United States Supreme Court held in the case of *Angers v. Ostby & Barton Company et al*, 335 U.S. 60, 80 USPQ 32:

“Numerous licenses under the patent were issued in the United States and other countries. The fact that this process has enjoyed considerable commercial success, however, does not render the patent valid. It is true that in cases where the question of patentable invention is a close one, such success has weight in tipping the scales of judgment toward patentability. *Good-year Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 279 (60 USPQ 386, 388), and cases cited in footnote 5 thereof. Where, as here, however, invention is plainly lacking, commercial success cannot fill the void. *Dow Chemical Co. v. Halliburton Co.*, 324 U. S. 320, 330 (64 USPQ 412, 416); *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350, 356-57 (41 USPQ 593, 595); *Textile Machine Works v. Hirsch Co.*, 302 U. S. 490, 498-99 (36 USPQ 37, 40); 1 Walker, Patents (Deller, 1937) §44. Little profit would come from a detailed examination of the cases cited above or

those indicated by reference. Commercial success is really a make-weight where the patentability question is close.

“Increased popular demand for jewelry or alertness in exploitation of the process may well have played an important part in the wide use of the patent. We cannot attribute Jungersen’s success solely or even largely to the novelty of his process.”

See also:

Alex Lee Wallau, Inc. v. J. W. Landenberger,
121 F. S. 555 (101 USPQ 383).

Chief Judge Clark, C. A. 2nd, cited the Jungersen decision with approval in the recent case of *Gentzel et al v. Manning*, supra:

“We perhaps should note the usual argument for validity because of alleged commercial success. Beginning in 1939 or perhaps earlier, Foster Engineering Company, the sole licensee, has sold about 3,000 Gentzel valves at prices ranging from \$300 to \$1,000, or a total of \$1,500,000, for which Gentzel has received royalty payments of about \$90,000. This somewhat modest success for a large operation over a long period does not carry conviction of unique worth. As we have again pointed out, *Kleinman v. Kohler*, 2 Cir., 108 USPQ 301, we must not be overnaive in evaluating such claims; and even a greater measure of success would not establish validity in the face of the clear showing here of anticipation by the prior art. *Jungersen v. Ostby*

& Barton Co., 335 U. S. 560, 567, 80 USPQ 32, 34-35, affirming *Jungersen v. Baden*, 2 Cir., 166 F. 2d 807, 811, 76 USPQ 488, 491. * * *.”

The above language and reasoning is particularly propous the present case.

**DEFENDANT, BERGMAN, IS NOT PERSONALLY
LIABLE**

Conclusion of Law IV (Tr. 52) and the Decree (Tr. 54) are to the effect that defendant, Harry X. Bergman, is personally liable for the alleged infringement of the Korter patent and an accounting is ordered against him.

Harry X. Bergman is the president and general manager of defendant, Perma-Lox Aluminum Shingle Corporation, and as such was in general charge of the design of the shingles which this corporation sold (Tr. 234).

An officer or director of a corporation is not individually or personally liable for infringement of a patent by the corporation where he has not acted beyond the scope of his office.

Powder Power Tool Corp. v. Powder Actuated Tool Co., supra;

Kinsel Corp. v. Haupt, 25 F. 2d 318;

Dangler v. Imperial Mach. Co., 11 F. 2d 945;

D'Arcy Spring Co. v. Marshall Ventilated Mattress Co., 259 Fed. 236.

There is no evidence that Mr. Bergman acted at any time, with respect to the alleged infringement of the Korter patent, other than as an officer of the Perma-Lox Corporation. There is no suggestion that he acted beyond the scope of his duties as president of defendant, Perma-Lox. Mr. Bergman should not be held to be personally and individually liable even if there is infringement of the patent in suit.

CONCLUSIONS

1. Korter was not the first inventor of a metal shingle.

2. Korter was not the first inventor to provide a metal shingle with reversely curved edge portions for loosely interlocking shingles together.

3. Korter was not the first inventor to provide a metal shingle with a nailing tab projecting from an upper corner.

4. Korter was not the first inventor to provide a metal shingle with stiffening ribs or corrugations extending the full height of the shingle.

5. Korter was not the first inventor to provide a metal shingle in which the lower interlocking flange formed a gutter.

6. Korter was not the first inventor to provide a metal shingle in which the gutter is provided with an opening for permitting drainage of water therefrom onto the outer surface of the lower shingle.

7. Korter was not the first inventor to provide a space between the lower end of one shingle and the curved flange at the upper end of the underneath shingle whereby condensation water could flow along the lower surface of the shingle into the gutter.

8. Korter was not the first inventor to provide a metal shingle with corrugations forming ridges on the inner surface of the shingle throughout the full height thereof.

9. Each and every one of the above elements is fully disclosed by the prior art.

10. The one and only thing Korter devised was a slot in the shingle gutter as an adjunct to the conventional open gutter for increasing the total drainage outlet area.

11. Defendants' shingle is not provided with any slot in the gutter.

12. Korter is precluded by file wrapper estoppel from asserting that the term "drain slot" in his claim is entitled to a broad interpretation so as to encompass an open-ended gutter.

13. Since Korter's invention is an extremely narrow one, he cannot by resort to the doctrine of equivalents expand his claim so as to cover structures which do not include a drain slot.

14. All of the elements provided in Korter's shingle are old and function in the same manner as shown in the prior art.

15. In order for a combination of old elements to be patentable, they must cooperate in some new way so as to produce a new and unexpected result.

16. Korter's shingle does not function in any new way or produce any new or unexpected result, and therefore the patent in suit directed to such shingle is invalid.

17. Since it does not under any circumstance constitute invention to provide a drain hole in a gutter, the Korter patent is invalid.

18. The decree of the District Court should be reversed and the Korter patent held to be not infringed and invalid.

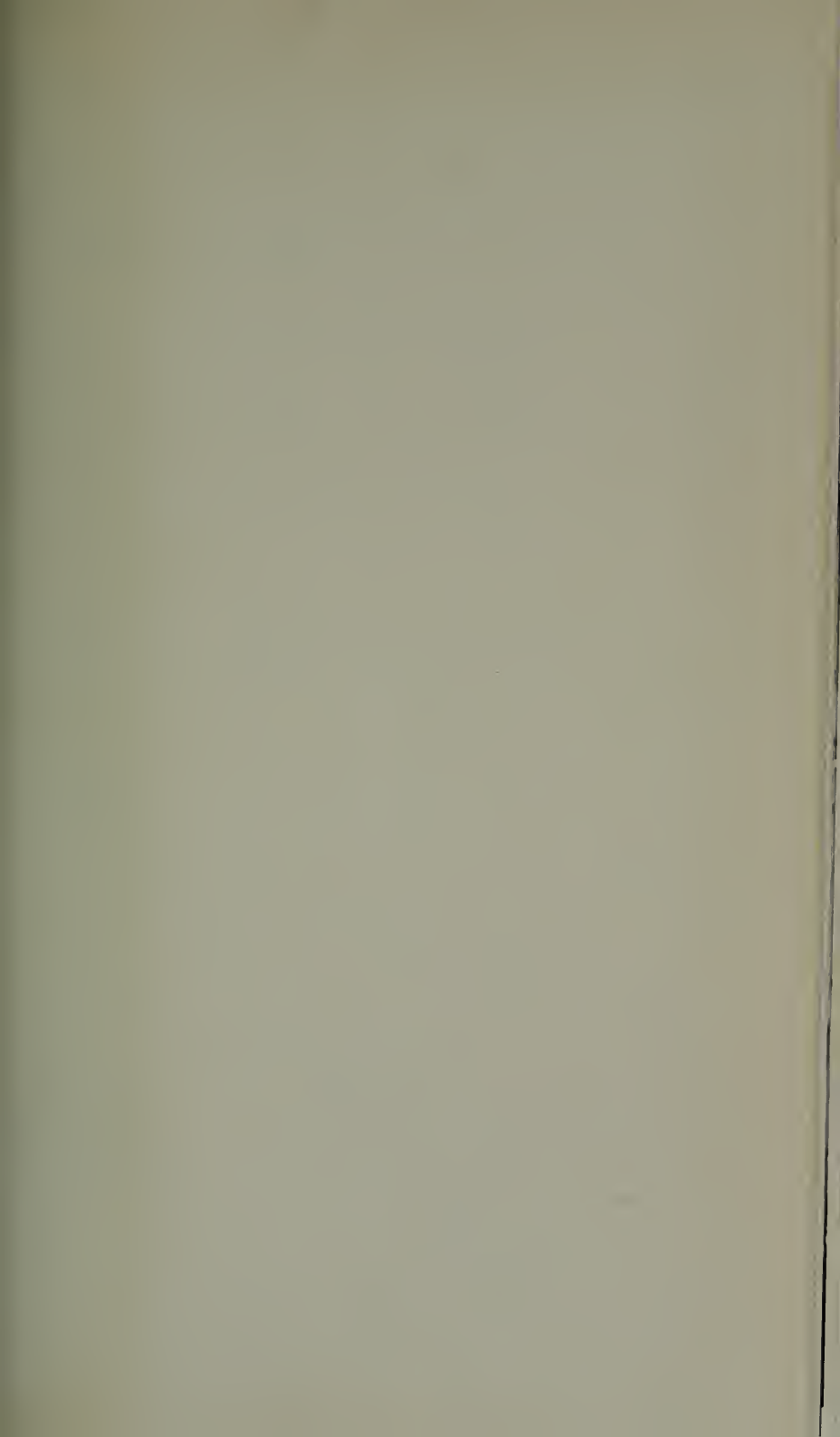
Respectfully submitted,

ELMER A. BUCKHORN

ROBERT F. MAGUIRE

J. PIERRE KOLISCH

Counsel for Appellants.

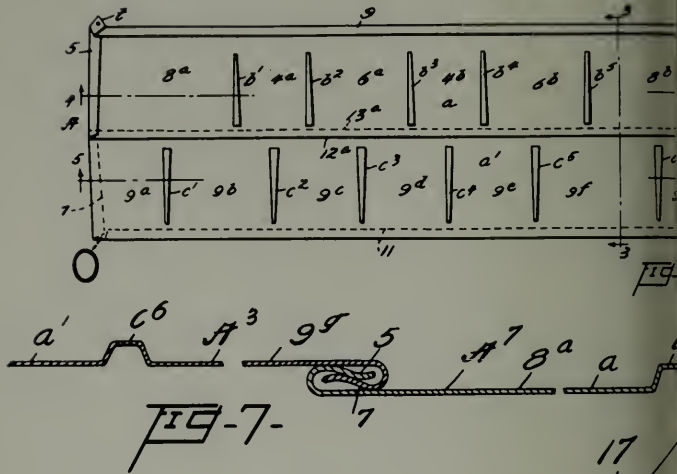


T. D. MILLER

May 27, 1941

2,243,

METAL ROOF COVERING



Note space between upper and lower shingles

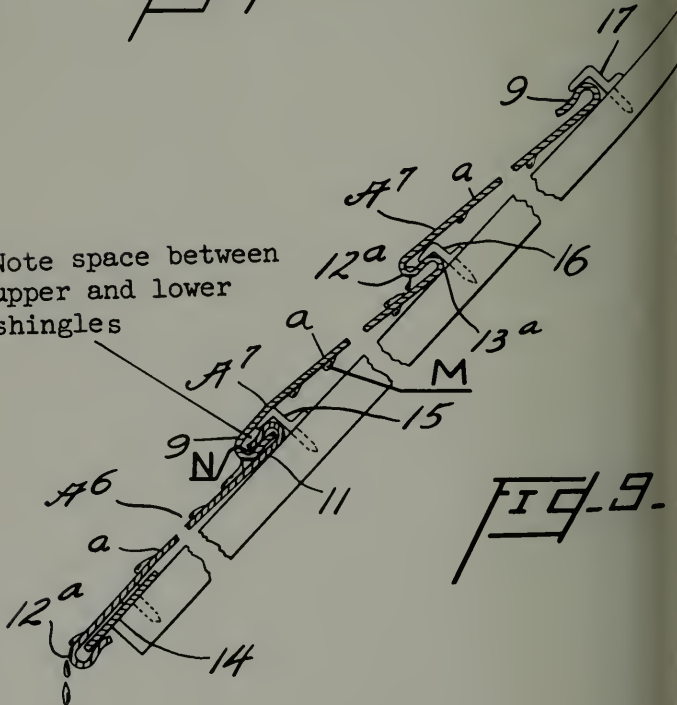


FIG. 9.

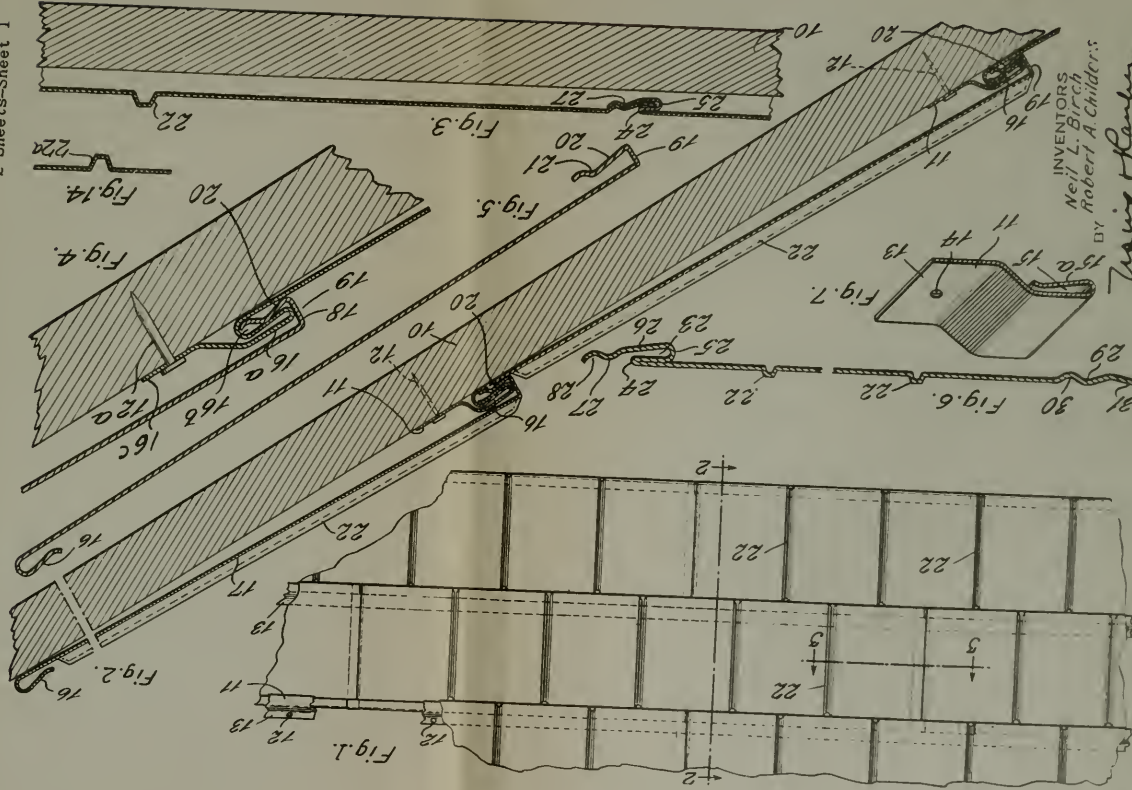
Sept. 19, 1939.

N. L. BIRCH ET AL
STRIP SHINGLE

2,173,774

Filed Dec. 20, 1937

2 Sheets-Sheet 1



INVENTORS
Neil L. Birch
By Robert A. Childers

Wm. H. Carter

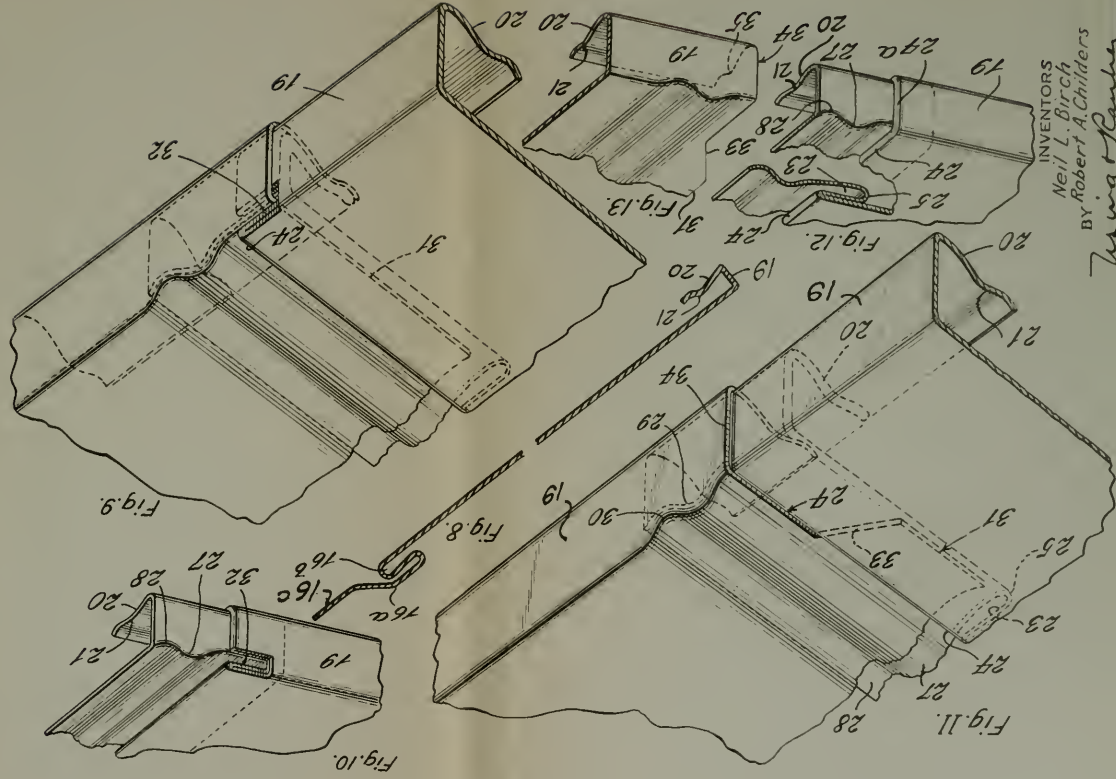
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N. L. BIRCH ET AL
STRIP SHINGLE

2,173,774

Filed Dec. 20, 1937

2 Sheets-Sheet 2



INVENTORS
Neil L. Birch
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UNITED STATES PATENT OFFICE

2,173,774

STRIP SHINGLE

Neil L. Birch and Robert A. Childers,
Birmingham, Ala.

Application December 20, 1937, Serial No. 180,873

2 Claims. (Cl. 108—17)

This invention relates to improvements in weatherproof coverings adapted to be used either for roofing or siding and aims to provide an improved construction of metallic strip shingle, which will have a good appearance and will simulate either shingled roofing or siding. Among the novel features herein described the improved shingle is formed of a long strip-like body or sheet as measured transversely, which is relatively shallow as measured from top to bottom. This body portion has oppositely bent hook portions at or near its top and bottom extremities and respective tongue and groove portions at its side edges, the groove portion at one edge extending around the bottom hook portion and the lower corner of the shingle being of such construction that the tongue of one shingle can be readily engaged with the grooved portion of a similar adjacent shingle and the hook portions of such interengaged shingles can telescopically overlap. This construction is secured either by slitting away or notching out the lower corner of the tongue and the part of the shingle adjacent thereto. These and other specific constructional features of the invention are hereinafter more fully described, claimed and illustrated in detail in the accompanying drawings, in which—

Fig. 1 is a plan view of a portion of a roof covered with strip shingles embodying the present invention; Fig. 2 is an enlarged section on line 2—3 of Fig. 1; Fig. 3 is a cross-section at right angles thereto on line 3—3 of Fig. 1, showing the manner of interlocking adjacent strip shingles at their side edges; Fig. 4 is an enlarged detail view illustrating a detailed modification; Fig. 5 is a detail view in cross-section of one of the shingles taken substantially on line 2—2 of Fig. 1; Fig. 6 is an enlarged detail view of a single shingle detached, taken on line 3—3 of Fig. 1, an intermediate portion being broken away, so as to permit showing on a legible scale; Fig. 7 is a detail perspective view of a shingle-holding cleat shown in Fig. 2; Fig. 8 is a detail view of the type of shingle shown in Fig. 4, wherein the holding cleat is formed integral with the shingle at the upper end thereof; Fig. 9 is a perspective view showing the bottom corners of two contiguous shingles interlocked with one another along their bottom and side edges; Fig. 10 is a detail view of the lower corner of one of the shingles shown in Fig. 9; Fig. 11 is a perspective view showing the bottom corners of two contiguous shingles interlocked with one

of interlock; Figs. 12 and 13 are perspective views of the lower corners of the shingles shown in Fig. 11, the views being disposed substantially in the relative positions that a pair of shingles are adapted to occupy just prior to being interlocked with one another; Fig. 14 illustrates an alternative detail.

Referring in detail to the drawings, 10 represents decking or sheathing boards to which a weather surface covering of our invention is adapted to be applied. In the embodiment of the invention illustrated in Figs. 1 and 2, at spaced intervals, cleats 11 are secured to the roofing by nails or suitable fastening devices, indicated at 12. Each cleat is bent to the hook-like form shown in perspective in Fig. 12, the upper extremity 13 of the cleat being adapted to seat on the roof and having a plurality of perforations 14 therein to facilitate passage of the nails 12 therethrough. On its lower end, each cleat is bent around to the hook-like configuration shown in Fig. 7 and providing a throat 16 adapted to receive a top hook portion 16 of the strip shingle. The extremity of the hook portion 16, as shown in Fig. 2, enters the throat 16 and the coaction of the parts when assembled is such that the cleat prevents upward movement of the shingle.

Each shingle strip, illustrated generally by numeral 11 in the drawings, has a bottom hook portion 16 the wall 19 of which is substantially perpendicular to the surface of the body of the shingle. Extending inwardly and upwardly from the wall 19, there is a flange 20, which is bent so as to form the angular upwardly directed portion 21, which portion is designedly intended to make a yielding engagement with the wall 16 of the hooked portion of the cleat. When the parts are assembled, as in Fig. 2, it is therefore apparent that there is an interlock between the upper end of one shingle, the lower end of the shingle thereabove and the cleat which is nailed to the roof.

In the modification shown in Fig. 4, instead of utilizing a separate cleat nailed to the roof the upper end of the shingle strip is provided with an upper hooked portion 16^a, which is formed by folding over the upper end of the shingle to the configuration shown in Fig. 8, so as to provide a securing flange 16^a at the top of the shingle, which is adapted to be nailed to the deck of the roofing by a nail 12^a shown in Fig. 4. In this embodiment of the invention, the flange 20 at the lower end of a coacting up-

engagement with the throat portion 16^b in much the same manner that the flange 20 interengages with the throat portion of the cleat of Fig. 2. The air space between the inclined flange of an upper shingle and the underlying surface of a lower shingle serves as a break to prevent capillary action, which would otherwise tend to draw water between the overlapped portions.

The strip shingles of our invention are relatively short, as measured from top to bottom, but are of considerable length, as measured from side to side. And to make such a long strip resemble several shingles, the length of the strip, as measured from side to side, is broken up by a plurality of division ridges 22, which give the long strip the appearance of a plurality of shingles. These division ridges may be upstanding as in Fig. 3 or alternatively they may be formed as depressions, such as shown at 22^a in Fig. 14. At the side edges, the shingles of our invention are interlocked and because of the interengagement of the hooked bottom end of the lower shingle with the upper end of another shingle special provision must be made to permit the ready assembly of the parts.

For interlocking the side edges of the contiguous shingle strips, we provide along one side edge of each shingle strip a locking groove 23, which is formed by folding the side portion of the shingle, as indicated at the fold 24 in Fig. 6. The side portion is again bent around, as indicated at 25, so as to form the lower wall por-

tion, such as shown in either Fig. 2 or Fig. 4 and the side edges of the sheets will be bent to the configuration shown in Fig. 6, so as to provide the same arrangement of tongue and groove portions 31 and 33 and the depressed portions 29 and rib 30 for engagement with side bead 21 and indentation 28. In this modification, however, in order to facilitate the side to side interengagement of adjacent sheets, the tongue 31 along one edge of the sheet is cut away, so as to provide a notch, such as indicated at 33, in Figs. 11 and 13.

By notching out the lower end of the tongue 31, as indicated at 33 in Fig. 13 and by cutting off a corresponding portion from the lower end of wall 19 of the sheet, along the line 34 and continuing this cut-away portion along the line 35 of the flange 20, it will be apparent that, when the tongue 31 is inserted in the side groove 23, the edge of the notch can be moved into abutment with the folded edge 24 of the adjacent sheet. Similarly, the edges 34 and 35 of the cut-away portion of the lower ends of the shingle and flange can be abutted against the fold 24^a of the folded portion, where it extends downwardly to follow the configuration of the end wall 19 of the lower portion of the shingle.

In all embodiments of the invention illustrated, the strip shingle may be said to comprise a body portion with oppositely bent hook-like portions at the top and bottom extremities thereof and side portions shaped to provide a tongue on one side and a groove on the opposite side the tongues

body having oppositely bent hook portions at its top and bottom extremities and side portions shaped to provide a tongue along one side edge of the sheet and a grooved portion along the opposite side edge of the sheet, the body of the sheet being bent adjacent such tongue and groove portions to an undulating form so as to provide a structure in which the contacting side portions of adjacent shingles will interlock with one an-

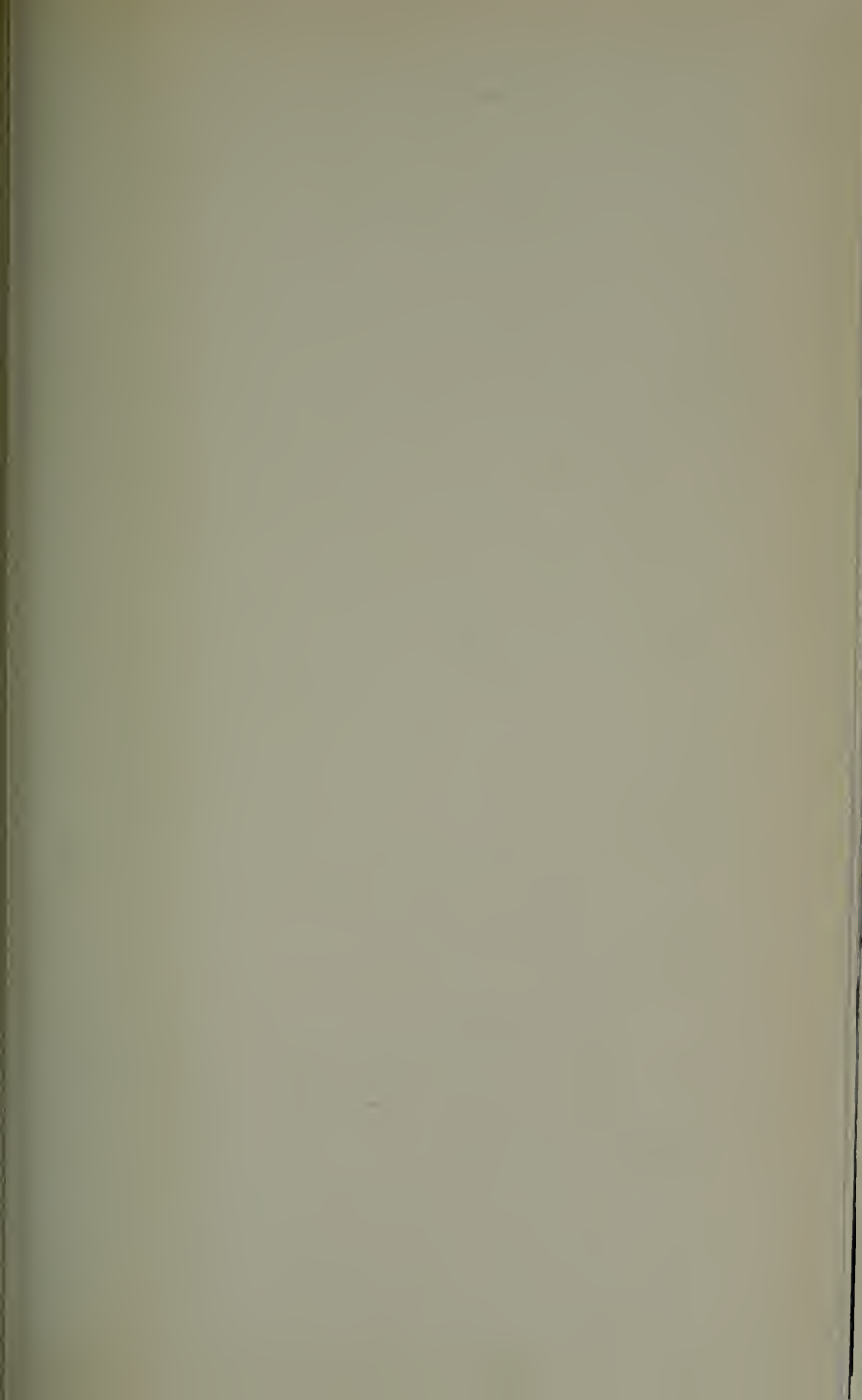
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other in such a way as to resist lateral separation of the shingles, a lower corner of the shingle having a slit opening into the grooved portion thereof so that the tongue portion of one shingle can be engaged with the grooved portion of a similar shingle and the hooked portions of such interengaged shingles can telescopically overlap.

ROBERT A. CHILDERS.

NEIL L. BIRCH.





T. D. MILLER

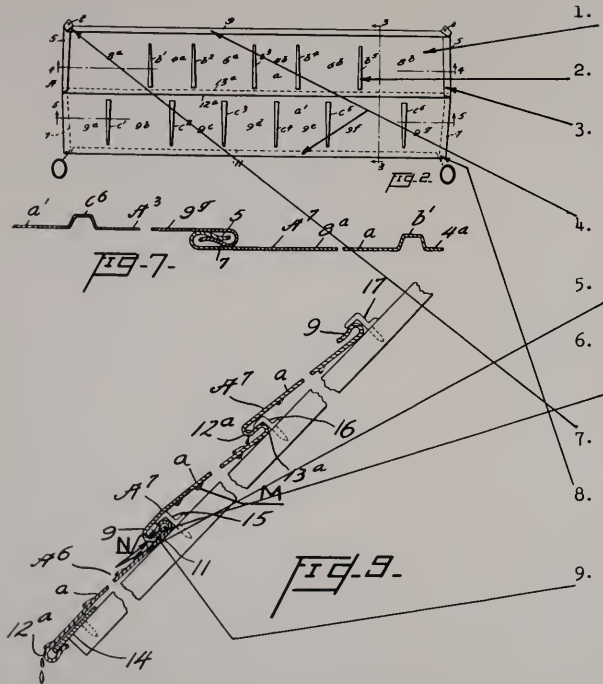
MAY 27, 1941

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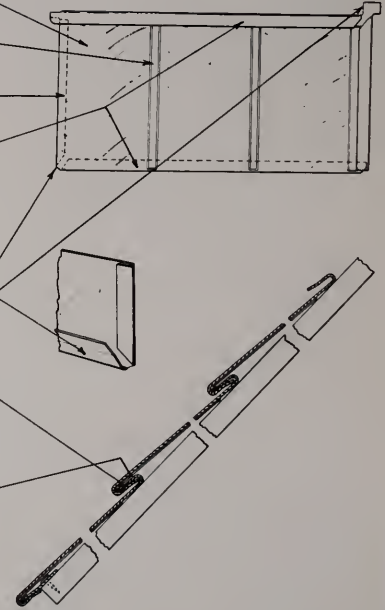
COMPARISON BETWEEN SHINGLES
OF MILLER AND DEFENDANT

DEFENDANT'S SHINGLE
(PX 3)

METAL ROOF COVERING



1. A flat, rectangular shaped metal shingle
2. Corrugations in said shingle spaced laterally of shingle
3. Lateral edges reversely turned on opposite faces providing curved edge portions for interlocking with adjacent shingles
4. Top and bottom edges reversely turned on opposite faces
5. Turned bottom portions forming a gutter
6. Reversely curved portion thereof engageable with reversely curved top edge portion of lower shingle to form close fit therebetween
7. A fastening tab for securing shingle to roof
8. The gutter having an open end for permitting drainage of water therefrom
9. The inner face of the upper shingle being spaced from reversely turned top edge of lower shingle so that moisture can travel along the inner face of the shingle into gutter.



12. 1911

12. 1911

